

Appl. No. 10/025,628

REMARKS/ARGUMENTS

Claim Rejections – 35 USC 103

The Examiner rejects claim 31 under 35 USC 103(a) as being unpatentable over United States patent No. 6,112,015 (“Planas”) in view of United States patent application publication No. 2002/0165934 (“Conrad”). This rejection is rendered moot, as claim 31 has been cancelled.

The Examiner rejects claims 35 and 36 under 35 USC 103(a) as being unpatentable over United States patent application publication No. 2004/0081308 (“Naik”) in view of United States patent No. 5,295,243 (“Robertson”). In response, Applicant respectfully traverses the Examiner’s rejection, as the Examiner has not fulfilled the requirements for establishing a *prima facie* case of obviousness. A first requirement is that the prior art of record must teach or suggest all the claim limitations. A second requirement is that there must be some suggestion or motivation to combine the prior art of record in a manner arriving at the claimed invention. Applicant’s analysis below demonstrates that the Examiner has not fulfilled either of these requirements.

Claim 35

Requirement to Teach or Suggest All Claim Limitations

Regarding claim 35, the Examiner concedes that “Naik fails to distinctly point out showing a route for a specific node”, but looks to the disclosure of Robertson for this subject matter. However, Applicant submits that Robertson has nothing to do with the present application. Robertson relates to the display of hierarchical 3-dimensional structures with rotating substructures. The “nodes” in Robertson are not nodes of an optical network. Instead, the nodes in Robertson are nodes of 3-dimensional structures. On this basis alone, Applicant submits that Robertson has nothing to do with the present application. Notwithstanding this, Applicant’s analysis below demonstrates that even if the nodes in Robertson are analogous to nodes of an optical network, Robertson would still fail to teach displaying “information respecting each route [emphasis added] which includes the selected node” as recited in claim 35.

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The Examiner contends that Robertson teaches “upon selection of a selective node displaying information respecting each route [emphasis added] which includes the selected node” in column 3, lines 52-59. Applicant respectfully disagrees. The portion of Robertson referred to by the Examiner teaches that “When the user indicates a node's selectable unit, the path is presented differently so that the user can more easily distinguish the path [emphasis added].” Robertson teaches that the path is a very specific path, namely it is “the path of links and nodes connecting a specific node to the uppermost node” in column 3, lines 52-54. With reference to Figure 1, node 44 has a path to the uppermost node and another path to the underlying node 32. However, Robertson teaches distinguishing only the path to the uppermost node. Therefore, Robertson does not teach displaying information respecting each route, as only information respecting a single path is provided.

In view of the foregoing, Applicant submits that neither Naik nor Robertson teach or suggest “upon selection of a selected node, displaying in tabular form in a routes panel, information respecting each route [emphasis added] which includes the selected node” as recited in claim 35 of the present application. Accordingly, Applicant submits that the requirement of teaching all limitations of the claim for establishing a *prima facie* case of obviousness has not been satisfied for claim 35.

Requirement to Establish Motivation to Combine References

Applicant notes that Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) sets out three possible sources of motivation to combine, namely A) the nature of the problem to be solved, B) the teachings of the prior art, and C) the knowledge of persons of ordinary skill in the art. It is respectfully submitted that the Examiner has not established a motivation to combine the references from any one of the three sources.

A. The Nature of the Problem to be Solved

The problem to be solved in Robertson is quite different from the problem to be solved in Naik. Robertson generally relates to the display of hierarchical three-dimensional structures with rotating substructures. The problem to be solved in Robertson is outlined in column 1, lines 8-53. The problem in Robertson is how to display a three-dimensional node-link structure

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with a hierarchical geometry within which the relative positions of the nodes and links can change without losing the perceived object consistency of a node or links or of a structure as a whole. The problem to be solved in Naik is described in paragraph 0021. Naik teaches that “the number of links in a complex cross-connect cannot usefully be viewed at once, so an operator interface for cross-connect management must provide some way to reduce the number of links seen at once”. Clearly this is completely different from the problem to be solved in Robertson.

Since the problem to be solved in Naik is completely different from the problem to be solved in Robertson, Applicant submits that there can be no motivation to combine Naik and Robertson based on the nature of the problem to be solved.

B. The Teachings of the Prior Art

Applicant submits that there is no teaching, suggestion, or motivation to combine Naik and Robertson in the references themselves. Applicant notes that Naik and Robertson do not refer to one another in their disclosures. Applicant further notes that the list of references cited in Robertson does not include Naik, while Naik has not been published with references cited. Applicant further notes that Robertson and Naik have different International and United States classifications, which indicates that Robertson and Naik belong to different technological fields. Therefore, Applicant submits that there is no suggestion in the cited references to combine the disclosures of Naik and Robertson.

Furthermore, Applicant submits that combining the disclosures of Naik and Robertson is improper. In *re Ratti*, 270 F.2d at 813, 123 USPQ at 352, the Court reversed the rejection holding the “suggested combination of references would require substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in basic principle under which the [primary reference] construction was designed to operate”. Applicant submits that by combining Naik and Robertson, which are completely different from one another, the Examiner is proposing a substantial reconstruction and redesign of their teachings. Therefore, by applying similar reasoning from *re Ratti*, Applicant submits that combining the disclosures of Naik and Robertson is improper.

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For at least the aforementioned reasons, Applicant submits that there can be no motivation to combine the disclosures of Naik and Robertson from the teachings of the prior art themselves.

C. the Knowledge of Persons of Ordinary Skill in the Art

As clearly stated *In re Kotzab*, 55 USPQ2d 1313, 1318 “Identification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie obviousness without a finding as to specific understanding or principle within knowledge of skilled artisan that would have motivated one with no knowledge of invention at issue to make combination in manner claimed” [emphasis added]. Applicant submits that the Examiner has not demonstrated suggestion in the knowledge of persons of ordinary skill in the art to combine Naik and Robertson in the manner claimed. Claim 35 recites features not found in Naik or Robertson, yet the Examiner has not demonstrated any specific understanding or principle within knowledge of a skilled artisan that would suggest combining Naik and Robertson in a manner that would arrive at such features of claim 35.

As clearly stated *In re Fine*, 5 USPQ2d 1596, 1600 “Patent and Trademark Office improperly rejected claimed invention for obviousness... since PTO therefore failed to satisfy its burden of establishing prima facie case of obviousness by showing some objective teaching or generally available knowledge that would lead one skilled in the art to combine teachings of existing references”. Since the Examiner has not demonstrated an objective teaching or generally available knowledge that would lead one skilled in the art to combine Naik and Robertson in a manner that would arrive at the claimed invention, Applicant submits that the Examiner has not fulfilled his burden of establishing prima facie case of obviousness.

In view of the foregoing, Applicant respectfully submits that the requirements for establishing a *prima facie* case of obviousness have not been satisfied for claim 35.

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Claim 36

Applicant respectfully submits that the requirements for establishing a *prima facie* case of obviousness have not been satisfied for claim 36 for similar reasons provided above in respect of claim 35.

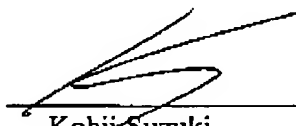
The Examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 103(a) directed against claims 35 and 36.

In view of the foregoing, early favorable consideration of this application is earnestly solicited.

Respectfully submitted,

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